

## **REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

### **I. CLAIM STATUS & AMENDMENTS**

Claims 1-11 are pending in this application.

Claims 1 and 6-9 were examined on the merits. Claims 1 and 6-8 were rejected and claim 9 was objected to.

Claims 2-5 and 10-11 were withdrawn as non-elected subject matter.

Claim 1 is amended to delete the term “high” before “high risk” at the end of the claim. Support can be found in original claim 1.

Claims 1 and 6-8 are amended to specify “the biological sample” as supported by the disclosure, for example, at page 12, line 27.

Other minor editorial revisions were made to claims 1 and 6-8 to better conform to US practice and English grammar form. These changes are non-substantive and do not narrow the scope of protection. Support can be found in the original claims.

Claims 6-8 are further amended to incorporate the subject matter of withdrawn claims 2-5.

Claim 9 is amended to proper multiple dependent form. Support can be found in original claim 9.

No new matter has been added.

## **II. CLAIM OBJECTIONS**

In item 3 on page 2 of the Office Action, claim 9 was objected to as being in improper multiple dependent form. The present amendment places claim 9 in proper multiple dependent form, thereby obviating this concern.

In item 4 on page 2, claims 6-8 were objected to for depending on withdrawn claims. The present amendment overcomes this rejection by amending claims 6-8 to incorporate the subject matter of withdrawn claims 2-5.

In view of the above, it is respectfully submitted that the above-noted claim objections should be withdrawn.

## **III. INDEFINITENESS REJECTIONS**

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite for the reasons set forth in item 6 on page 3 of the Action.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, the objected term “high” as been removed before “risk” at the end of the claim. Thus, the present amendment overcomes this rejection.

## **IV. ENABLEMENT REJECTION**

In items 8 and 9 on pages 3-6 of the Action, claims 1 and 6-8 were rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification is only enabling for the claimed diagnostic method using endometriotic tissue as the sample, and not for any biological sample.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, the claims have been amended along the lines indicated as enabled by the Office. In particular, the amended claims specify that the biological sample is endometriotic tissue or menstrual blood. Support can be found in the disclosure, for example, at page 12, line 27.

Further, it is well established in the medical and biotechnological fields that a DNA sample obtained from blood can be used in a diagnostic method using routine procedures and techniques without undue experimentations. As acknowledged by the Office, the specification discloses experiments performed using endometriotic tissues. See items (A) and (C) on page 4 of the Office Action. Accordingly, the specification clearly provides working examples of the amended claimed invention.

For this reason, it is respectfully submitted that the skilled artisan could practice the claimed invention using a biological sample obtained from endometriotic tissue or menstrual blood using common and routine procedures without undue experimentation.

Therefore, the above-noted 112, first paragraph, enablement rejection of claims 1 and 6-8 is untenable and should be withdrawn.

## **V. PRIOR ART REJECTIONS**

In items 11 and 12 on pages 6 and 7 of the Action, claims 1, 6 and 8 were rejected under 35 U.S.C. § 102(a) as anticipated by Oikawa et al. (J. Pathol., Vol. 199, No. 3, pp. 318-323, 2003).

In item 14 on pages 8-10, claims 1 and 6-8 were rejected under 35 U.S.C. § 103(a) as being obvious over Oikawa in view of Fujise (US 2003/0172388).

For the sole purpose of expediting prosecution and not to acquiesce to these rejections, enclosed herewith is a Declaration which removes Oikawa et al. as a prior art reference.

Kindly note that the Oikawa et al. reference was published on January 13, 2003, which is within one year of the effective U.S. filing date of this application (which in this case is the international filing date of the PCT application, January 13, 2004 for PCT/JP2004/000159). Also, the inventors of the instant application are co-authors of the Oikawa et al. reference.

The Declaration shows that the Oikawa et al. reference is not by "another." In doing so, the Declaration shows that the Oikawa et al. reference is a publication of the inventor's own invention and the inventor is a co-author of the publication. Accordingly, the Declaration establishes that the Applicants were the sole inventors of the instant invention and that the other named co-authors were merely working under the Applicants' direction.

Thus, since the Declaration removes the Oikawa et al. publication as a 102(a) reference, the above-noted prior art rejections are untenable and should be withdrawn.

## VI. CONCLUSION


In view of the foregoing amendments and remarks, that the present application is in condition for allowance and notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned at the telephone number below.

Respectfully submitted,

Masahiko KURODA et al.

By: \_\_\_\_\_

  
Jay B. Williams

Registration No. 48,036

Attorney for Applicant

JFW/led  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
September 26, 2007

## **ATTACHMENT**

1. Declaration.